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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALKA MAHENKRAKAR, KEHANG CHEN, and LUIS OBREGON

Appeal 2016-007118
Application 14/246,991[1]
Technology Center 2400

Before HUNG H. BUI, MICHAEL M. BARRY, and PHILLIP A. BENNETT, *Administrative Patent Judges*.

BUI, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Non-Final Rejection of claims 1–20, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.[2]

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[1] According to Appellants, the Real Party in Interest is Trans Union LLC. App. Br. 2.

[2] Our Decision refers to Appellants' Appeal Brief filed December 12, 2015 ("App. Br."); Examiner's Answer mailed May 5, 2016 ("Ans."); Non-Final Office Action mailed July 15, 2015 ("Non-Final Act."); and original Specification filed April 7, 2014 ("Spec.").

STATEMENT OF THE CASE

Appellants' Invention

Appellants' invention relates to "systems and methods for authenticating the identity of an individual prior to allowing access to confidential or secure information pertaining to that individual, such as a credit file or report, [i.e., credit scores from credit bureaus such as True Credit® by TransUnion, VantageScore® by VantageScore Solutions LLC, FICO® by Fair Isaac Corporation] particularly over computer connections across a network, such as the Internet." Spec. ¶¶ 1–2; Abstract. According to Appellants, "credit bureaus cannot rely on a consumer having a password, but must authenticate the consumer through other means should they seek access to their credit file." Spec. ¶ 8. As such, Appellants propose using a series of personal questions, via a website interface, to which a consumer must answer correctly for authentication before granting access to confidential information pertaining the consumer. Spec. ¶ 9.

Representative Claim

Claims 1, 12, and 18 are independent. Claim 12 is representative of Appellants' invention and is reproduced:

> 1. A method for authenticating the identity of a user seeking access to data related to the user via a client device in communication with a server, the method comprising the steps of:
>
> receiving a plurality of exam definitions through a customer interface from an entity that manages the confidential data of the user;
>
> requesting by the server, and receiving from the client device, initial data entered by the user;

> searching a database in communication with the server for a set of confidential data including at least one portion of the initial data;
>
> generating an exam comprising at least one question based at least in part on a portion of the confidential data relating to the user, wherein the exam creation function creates the exam based on the plurality of exam definitions;
>
> transmitting the exam to the client device for presentation to the user;
>
> determining at the server whether the user passed the exam; and
>
> granting access to the confidential data related to the user if the server determines that the user passed the exam.

App. Br. 32 (Claims App'x).

Examiner's Rejection

Claims 1–22 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject. Non-Final Act. 3–4.

ANALYSIS

With respect to independent method claim 12, and similarly, system claim 1 and "computer readable medium" claim 18, the Examiner finds these claims are directed to an abstract idea of "comparing new and stored information and using rules to identify options," i.e.,

> comparing of user inputted answers with pre-stored user answers that dictates when the inputted answer matches the pre-stored answer to an authentication examination question, a rule allows the user access to the confidential data or when an answer does not match, a rule blocks the user access to the requested confidential data.

Ans. 10; *see also* Non-Final Act. 3. In particular, the Examiner finds Appellants' claims 1–20 are directed to:

> an application on a server that selectively controls access to user confidential data, where the application includes an exam creation function that allows the server to create examination questions or challenge questions based at least in part on the stored confidential data of the user in an external database; an exam administration function that forces the server to send the created examination questions to the user client interface, if the user answers all questions correctly, the user is allowed to access the confidential information . . . .

Non-Final Act. 3. The Examiner also finds additional elements recited in these claims do not amount to significantly more than the abstract idea itself. *Id.* According to the Examiner, any reference to "computer-implemented" using a "processor" to implement the abstract idea does not transform the abstract idea into a patent eligible subject matter under 35 U.S.C. § 101. *Id.* Likewise, the Examiner reasons:

> [t]he request for access to confidential data and the response of generated examination questions mechanism is a generic computing operation that does not enhance the functionality of the computer. Further, the *claim does not recite an improvement to another technology or technical field, an improvement to the functioning of the computer itself*, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment.

Id. (emphasis modified).

Appellants present several arguments against the § 101 rejection. First, Appellants contend

> the Examiner ignored meaningful limitations that require specific structure for the authentication tool recited in the claims, such as, for example, a customer interface with one or more input

> fields configured to receive a plurality of exam definitions entered by an entity that manages the confidential data of the user . . . .

App. Br. 11; *see also id.* at 11–12.

Second, Appellants contend "the Office Action provides conclusory statements regarding the purported 'additional elements' with little to no written explanation or analysis to support its conclusion." *Id.* at 12 (citing Non-Final Act. 4). Instead, Appellants argue these claims contain additional elements, such as (1) a server hosting a specific application, (2) at least one database . . . to allow the server to retrieve . . . confidential data, and (3) a customer interface, and when these features "are considered individually and as an ordered combination, amount to significantly more than simply applying the alleged abstract idea of 'comparing new and stored information and using rules to identify options.'" *Id.* at 12–14.

Third, Appellants contend "claims 1–20 are not directed to an abstract idea." *Id.* at 15–21. In particular, Appellants argue

> representative Claim 1 is generally directed to a networked system that includes (1) one or more databases for storing the confidential data of a user, (2) a customer interface with input fields for receiving exam definitions entered by the entity that manages the user's confidential data, and (3) a server for hosting an application that provides the user with selective access to the confidential data, via a client interface.

Id. at 16. Similarly, Appellants argue "the claimed invention is not directed to mental processes that can be, and are routinely, performed without a computer," citing *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 Fed. Appx. 950 (Fed. Cir. 2014). *Id.* at 17–18. Likewise, Appellants argue none of the functions related in claims 1–20 involves "mathematical concepts." *Id.* at 19–20.

Fourth, Appellants argue "Claim 1 clearly does not attempt to tie up the use of all authentication tools on all computers across all networks. Rather, Claim 1 recites specialized elements that limit the claim to a specific application of the alleged abstract idea on specific computers in a specific networked system." *Id.* at 22. Fifth, Appellants also argue, "like the claims at issue in *DDR Holdings v. Hotels.com,* 773 F.3d 1245 (Fed. Cir. 2014)," "Claim 1 provides a technical solution that is necessarily rooted in computer technology in order to overcome a technical problem specifically arising in the realm of identity authentication over a network." *Id.* at 23; *see also id.* at 24–26. Lastly, Appellants argue "Claim 1 is inextricably tied to one or more particular machines, thereby satisfying at least the machine prong of the machine-or-transformation test and further evidencing its patent-eligibility." *Id.* at 27 (citing *In re Bilski*,[3] 545 F.3d 943, 954 (Fed. Cir. 2008) (en banc)).

We are not persuaded by Appellants' arguments. The Supreme Court has long held that "[l]aws of nature, natural phenomena, and abstract ideas are not patentable." *Alice*, 134 S. Ct. at 2354 (quoting *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013) (internal quotation marks omitted)). The "abstract ideas" category embodies the

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[3] In *In re Bilski*, the Federal Circuit adopted a "machine-or-transformation" (MoT) test to determine whether a process claim is eligible under 35 U.S.C. § 101. However, the Supreme Court held, in *Bilski v. Kappos*, 130 S. Ct. 3218, 3227 (2010), that the "MoT" test, while a "useful and important clue," is no longer the sole test for determining the patent-eligibility of process claims under § 101. Since *Bilski v. Kappos*, the Supreme Court has created a two-step framework in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014) to address whether a claim falls outside of § 101, which we discuss *infra*.

longstanding rule that an idea, by itself, is not patentable. *Alice Corp.*, 134 S.Ct. at 2355 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)).

In *Alice*, the Supreme Court sets forth an analytical "framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). The first step in the analysis is to "determine whether the claims at issue are directed to one of those patent-ineligible concepts," such as an abstract idea. *Id.* If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims "individually and 'as an ordered combination'" to determine whether there are additional elements that "'transform the nature of the claim' into a patent-eligible application." *Id.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297). In other words, the second step is to "search for an 'inventive concept'—*i.e.*, an element or combination of elements that is 'sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.'" *Id.* (brackets in original) (quoting *Mayo*, 132 S. Ct. at 1294).

Turning to the first step of the *Alice* inquiry, we agree with the Examiner that method claim 12 and its corresponding system claim 1 and "computer readable medium" claim 18 are directed to a patent-ineligible abstract concept of "comparing new and stored information and using rules to identify options." Non-Final Act. 4. All the steps recited in Appellants' method claim 12 and "computer readable medium" claim 18, including, for example: (i) "receiving a plurality of exam definitions" in advance, (ii) "receiving . . . initial data entered by the user," (iii) "generating an exam

comprising at least one question . . . based on the plurality of exam definitions," (iv) "transmitting the exam to the client" and (v) "determining . . . whether the user passed the exam" before (vi) "granting access to the confidential data," are abstract processes of collecting, storing, and analyzing information of a specific content prior to granting access to the content. System claim 1 recites similar limitations in the context of (i) a server hosting an application providing selective access, (ii) a database storing the confidential data, and (iii) a customer interface to allow input of exam definitions. Nevertheless, information as such is intangible. *See Microsoft Corp. v. AT & T Corp.*, 550 U.S. 437, 451 n.12 (2007). Information collection and analysis, including when limited to particular content, is within the realm of abstract ideas. *See, e.g., Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1349 (Fed. Cir. 2015); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); and *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011).

Turning to the second step of the *Alice* inquiry, we find nothing in method claim 12 and similarly, in system claim 1 or "computer readable medium" claim 18, that adds anything "significantly more" to transform the abstract concept of collecting, storing, and analyzing information into a patent-eligible application. *Alice*, 134 S. Ct. at 2357. Appellants do not argue each of the steps of (i) "receiving a plurality of exam definitions" in advance, (ii) "receiving . . . initial data entered by the user," (iii) "generating an exam comprising at least one question . . . based on the plurality of exam definitions," (iv) "transmitting the exam to the client" and (v) "determining . . . whether the user passed the exam" before (vi) "granting access to the

confidential data," is individually inventive. None of Appellants' arguments show that some inventive concept arises from the ordered combination of these steps, which, even if true, would be unpersuasive given that they are ordinary steps in data analysis and are recited in the ordinary order. Instead, claims 1, 12, and 18 simply incorporate a general-purpose computer and generic components such as "database" and "customer interface" to perform the abstract concept of "comparing new and stored information and using rules to identify options," i.e., collecting, storing, and analyzing information.

As recognized by the Federal Circuit in *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014), *Bilski's* "machine-or-transformation" (MoT) test can provide a "useful clue" in the second step of the *Alice* framework. Under *Bilski's* MoT test, a claimed process is patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus; or (2) it transforms a particular article into a different state or thing. *Bilski*, 545 F.3d at 954 (citing *Gottschalk*, 409 U.S. at 70). However, contrary to Appellants' arguments, Appellants' method claim 12 and its corresponding system claim 1 and "computer readable medium" claim 18 are neither sufficiently "tied to a particular machine or apparatus" nor involved in any type of transformation of any particular article.[4]

For example, limiting such an abstract concept of "comparing new and stored information and using rules to identify options" to a general purpose computer having generic components such as "database" and "customer interface" recited in Appellants' claims 1, 12, and 18 does not

[4] *Alice* also confirmed that if a patent's systems claims are no different in substance from its method claims, they will rise and fall together. 134 S. Ct. at 2360. The same was true of the *Alice* patent's media claims. *Id.*

make the abstract concept patent-eligible under 35 U.S.C. § 101. Ans. 3. As recognized by the Supreme Court, "the mere recitation of a generic computer cannot transform a patent ineligible abstract idea into a patent-eligible invention." *See Alice*, 134 S. Ct. at 2359 (concluding claims "simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer" not patent eligible); *see also Ultramercial,* 772 F.3d at 715–16 (claims merely reciting abstract idea of using advertising as currency as applied to particular technological environment of the Internet not patent eligible); *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (claims reciting "generalized software components arranged to implement an abstract concept [of generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer" not patent eligible); and *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) ("[s]imply adding a 'computer aided' limitation to a claim covering an abstract concept, without more, is insufficient to render [a] claim patent eligible" (internal citation omitted)).

As further recognized by the Examiner,

> appellants['] claimed invention can [also] be recited as a mental process or by pencil and paper. For examiner, I write a question on a piece of paper that conveys a challenge question that reflects my knowledge of the user and the security requirements of a service provider of a filing cabinet, if the user writes the wrong answer down on piece of paper and hands it back to me, I do not give the user a file cabinet key to access the filing drawer of the service provider.

Ans. 22–23. Likewise, Appellants' claimed

> customer interface mechanism is a generic computing operation that does not enhance the functionality of the computer, . . . does not recite an improvement to another technology or technical field of challenge response, nor does the customer interface claim limitation improve the functioning of the computer itself, further applicant's customer interface does not implement a meaningful limitation beyond the generally linking of an abstract interface to a particular technological environment.

Ans. 28.

In contrast to *DDR Holdings* and the recent Federal Circuit's decision in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), in which the Federal Circuit held that claims directed to specific improvements in computer capabilities (i.e., self-referential table for a computer database) are patent-eligible subject matter, Appellants' claims 1–20 are neither rooted in computer technology nor do they seek to improve any type of computer capabilities, such as *Enfish's* "self-referential table for a computer database." Instead, Appellants' claims 1–20 simply recite an abstract concept of "comparing new and stored information and using rules to identify options," i.e., collecting, storing, and analyzing information.

Because Appellants' claims 1, 12, and 18 are directed to a patent-ineligible abstract concept and do not recite something "significantly more" under the second prong of the *Alice* analysis, we sustain the Examiner's rejection of these claims as well as respective dependent claims 2–11, 13–17, and 19–20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter in light of *Alice* and its progeny.

CONCLUSION

On the record before us, we conclude Appellants have not demonstrated the Examiner erred in rejecting claims 1–20 under 35 U.S.C. § 101.

DECISION

As such, we AFFIRM the Examiner's § 101 rejection of claims 1–20.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED